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MYERS BIGEL SIBLEY SAJOVEC P.A.			EXAMINER	
PO BOX 37428			PHAN, JOSEPH T	
RALEIGH, NC 27627			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/782,772

Applicant(s)

KOVALES ET AL.

Examiner

Joseph T. Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/29/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-42, 44-59 and 61-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-42, 44-59 and 61-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 57-59 and 61-82 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 57 recites "a computer program product....the computer program product embodied on one or more computer-readable media and comprising computer-readable program code..."

Claiming a computer program product embodied on computer-readable media comprising code is non-statutory as the specification states that the claimed computer program product can "include but is not limited to disk, cd, and so forth..." Examiner recommends amending the claims to read "a computer-readable medium comprising computer program instructions...." As supported on page 34 of applicant's specification. Appropriate clarification and/or correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**4. Claims 1-4, 6-7, 12-20, 22-37, 41-47, 49-59, 61-62, 67-72, and 74-91 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel, et al., Patent #5,943,402 in view of Valco et al., Patent #6,442,243.**

Regarding claims 1, 33, and 57, Hamel teaches a method, system and computer program product for providing at least one bookmark for a voice mail message by a caller leaving the voice mail message, wherein at least one bookmark is used to mark one or more segments of the voice mail message(*col.3 lines 3-55 and col.4 lines 63-67, col.5 lines 34-48, and col.8 lines 35-67*).

Hamel is silent about disclosing these bookmarks as having one or more different degrees of importance.

However, in the same field of endeavor of managing voicemails, Valco teaches bookmarks having one or more different degrees of importance (Valco col.12 lines 55-59).

It would have been obvious to a person of ordinary skill in the art at the time the

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invention was made to modify Hamel's marked segments(Fig.3A) to include one or more different degrees of importance as taught by Valco in order to distinguish the segment as urgent or not as this would allow a more efficient way to manage voicemails. Furthermore, Valco uses the same standard twelve key touch tone telephone keypad as suggested by Hamel(col.2 lines 19-21 and col.3 lines 6-10) for marking.

Regarding claims 2, 34, and 82 Hamel in view of Valco teaches a method, system and computer program product according to claims 1, 33, and 57 further comprising the step of creating a bookmarked message from the voice mail message and the at least one bookmark(*col.5 lines 16-48 and col.8 lines 35-67*)

Regarding claim 3, 35, and 58, Hamel in view of Valco teaches a method, system and computer program product according to claims 2, 34, and 82 further comprising the step of playing the bookmarked message to a listener (*col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 4, 36, and 59, Hamel in view of Valco teaches the method, system and computer program product according to claims 1, 33, and 57 wherein at least one bookmark segments the voice mail message according to one or more topics(*col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 6 and 61, Hamel in view of Valco teaches the method, system and computer program product according to Claims 1, 37, and 57 wherein a default degree of importance is associated with segments not otherwise marked (Valco col.12 lines 55-59 page 5 para 0069).

Regarding claims 7, 37, and 62, Hamel in view of Valco teaches the method, system and computer program product according to claims 1, 33, and 57 wherein at least one bookmark corresponds to one or more special types of information in the voice mail message (Valco col.12 lines 55-59 page 5 para 0069).

Regarding claim 67 Hamel in view of Valco teaches a computer program product according to claim 59 further comprising code configured to use the at least one bookmark to navigate from one topic of the voicemail to another(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 14, 41, and 68, Hamel in view of Valco teaches a method, system and computer program product according to claims 2, 34, and 58 further comprising the step of using the at least one bookmark to perform actions selectively on one or more segments of the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67; listening to the segment is an action*).

Regarding claim 15, 42, and 69, Hamel in view of Valco teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments are associated with a topic of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67; the beginning of the voicemail message is a topic for the selected segments*).

Regarding claim 16, 43, and 70, Hamel in view of Valco teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments have one or more different degrees of importance(Valco col.12 lines 55-59 page 5 para 0069).

Regarding claims 17, 47, and 72 Hamel in view of Valco teaches a method, system and computer program product according to claims 14, 41 and 68, wherein the selected segments are associated with one or more special types of information in the voice mail message(*col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 18, 44, and 71, Hamel in view of Valco teaches a method, system and computer program product according to claims 14, 41, and 68, wherein the actions comprise one or more of saving, deleting, forwarding, listening, skipping, or repeating the one or more segments, and marking a particular segment as protected or confidential prior to forwarding the marked segment to another party (*Valco col.12 lines 55-59*).

Regarding claim 19 and 45 Hamel in view of Valco teaches a method, system and computer program product according to claims 18 and 44, wherein the actions further comprise marking a selected segment as protected or confidential (*Valco col.12 lines 4-7 and 55-59*).

Regarding claim 20 and 46 Hamel in view of Valco teaches a method, system and computer program product according to claims 19 and 45 further comprising forwarding the segment marked as protected or confidential to another party (*Valco col.11 lines 45-55 and col.12 lines 55-59*).

Regarding claim 22 Hamel in view of Valco teaches the method according to claim 2, wherein the creating step further comprises storing the bookmarks and the voice mail message separately as the bookmarked message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 23 Hamel in view of Valco teaches the method according to claim 2 wherein the creating step further comprises storing the bookmarks and the voice mail message intermingled as the bookmarked message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 24, 49, and 74 Hamel in view of Valco teaches a method, system and computer program product according to claims 3, 35, and 58, further comprising announcing for the bookmarked voice mail message, a number of the bookmarked segments in the voicemail message (*Valco col.5 lines 21-38, Hamel col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 25-26, 50, 75, 83-86 Hamel in view of Valco teaches a method, system and computer program product according to claims 1, 3, 7, 33, 35, 37, 58, 60, and 62 further comprising announcing, before, during, or after playing the voicemail message, the different degree of importance in the voice mail message and a number of segments thereof (*Valco col.5 lines 21-38, Hamel col.5 lines 22-48, col.7 lines 1-8, and col.8 lines 35-67; displaying is also announcing*).

Regarding claims 27, 51, 76, 87-88 Hamel in view of Valco teaches a method, system and computer program product according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62 further comprising announcing, before and after playing the voicemail message, the special types of information in the voicemail message (*Valco col.5 lines 21-38, Hamel col.5 lines 22-48, col.7 lines 1-8, and col.8 lines 35-67; displaying is also announcing*).

Regarding claims 28, 52, and 77 Hamel in view of Valco teaches the method,



system and computer program product according to claims 7, 37, and 62 wherein particular ones of the special types of information are required, and further comprising the step of prompting the caller to provide input for each particular one for which no bookmark is otherwise provided(*col.5 lines 16-48, and col.8 lines 35-67, Valco col.5 lines 21-38*).

Regarding claims 29, 53, and 78 Hamel in view of Valco teaches the method, system and computer program product according to claims 2, 34, and 58 further comprising the step of associating one or more audio cues with one or more bookmarks of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 30, 54, and 79 Hamel in view of Valco teaches the method, system and computer program product according to claims 29, 53, and 78 further comprising the steps of playing the bookmarked message to a listener; and incorporating the one or more associated audio cues along with respective portions of the voice mail message corresponding to the one or more bookmarks (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 31, 55, and 80 Hamel in view of Valco teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue with its respective portion of the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 32, 56, and 81 Hamel in view of Valco teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue in-line with its respective portion of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 89-91 Hamel in view of Valco teaches a method, system and computer program product according to claims 1, 33, and 57 wherein the caller provides a plurality of bookmarks for the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

**5. Claims 8-10, 38, 40, and 63-66 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel in view of Valco further in view of Parsons et al., Patent #6,970,906.**

Regarding claims 8-10, 38, 40, and 63-66 Hamel in view of Valco teaches the method, system and computer program product according to claims 7, 37, and 62.

Hamel is silent about disclosing wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator.

However, in the same field of endeavor of managing voicemails, Parsons

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teaches wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator(Parsons col.6 lines 16-35 *and col.9 lines 49-57*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hamel's marked segments(Fig.3A) to include a callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator(Parsons col.6 lines 16-35) as this would allow a more efficient way of handling voicemails.

**6. Claims 11, 21, 39, 48, and 73 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel in view of Valco further in view of Haddock, Patent #5,742,736.**

Regarding claims 11, 21, 39, 48, and 73 Hamel in view Valco teaches a method, system and computer program product according to claims 17, 37, 47, and 72.

Hamel is silent on wherein at least one of the special types of information comprises a uniform resource locator(URL) and where at least one of the actions comprises automatically establishing a connection to the URL.

However, in the same field of endeavor, Haddock teaches viewing and manipulating voice mail messages on a computer display and the contents thereof can

be retrieved and connected to applications on the computer (col.4 lines 38-54).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include a computer display like in Haddock to view and access information within voice mail messages as taught in Hamel(col.1 lines 45-52).

One of ordinary skill in the art would have been motivated to do this as automatically connecting to a URL via a displayed hyperlink is old and well-known in the art and since Haddock's user is able to use information(e.g. phone #, points of interest, etc.) to automatically establish a connection to it, URL's are just an example of points of interest that can be accessed with a computer application(e.g. "Internet Explorer").

#### **Response to Arguments**

7. Applicant's arguments filed 05/29/07 with respect to claims 1-4, 6-42, 44-59, and 61-91 have been considered. This office action presents new ground(s) of rejection.

In response to Applicant's argument, that the secondary reference Valco, does not disclose marking a plurality of segments of a voicemail message as having one or more different degrees of importance, it is noted that the examiner only uses Valco as a teaching reference to show that files can be marked as either important or not(see Valco col.12 lines 55-59). The primary reference, Hamel, teaches marking a plurality of segments, therefore the secondary reference need only to disclose the silent features per U.S.C. 103(a) practice. Prima Facie is established with Valco as both Hamel and Valco are in the same field of endeavor, Valco again is used only to show that marking messages with different degrees of importance is not novel as Valco teaches two different degrees of importance, either urgent or not (Valco col.12 lines 55-59).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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